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10/789,183

02/26/2004

Peter J. Coassin

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11/13/2006

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EXAMINER

LUDLOW, JAN M

ART-UNIT

PAPER NUMBER

1743

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/789,183

**Applicant(s)**

COASSIN ET AL.

**Examiner**

Jan M. Ludlow

**Art Unit**

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 72-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-18 and 72-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/26/2004, 6/15/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/23/2006.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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1. Claims 1, 3-18, 72-85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 72, "reagent container configured to receive...such that..." is unclear in that it is unclear whether a source of pressurized air is being positively recited, or what structural features are intended by "configured to...".

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3-6, 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun (6780648) in view of Sollbohmer (2002/0051737)

Sun teaches a dispenser having a battery 12 of pumps 42 (instant pressurization) coupled to reagent containers 26 and dispensing tips via solenoid valve 32, shown in a compact arrangement in figure 1. The dispenser and an XYZ positioning table under computer control position an assay plate to delivery test solutions to wells (col. 3, lines 8-47).

Sun fails to teach the dispensers in a module removably attached to a frame.

Sollbohmer teaches a dispensing module including tips 12, pumps 46 and reagent containers 24 on head 10 removably coupled to frame 22 by sliding (quick) connectors 50, 52.

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5. It would have been obvious to one of ordinary skill in the art to provide the tips, pumps, valves and reagent containers of Sun in a dispensing module like that of Sollbohmer in order to provide an easily replaceable dispensing module in an analytical device as taught by Sollbohmer. It is the examiner's position that the reagent containers of Sun are structurally capable of receiving pressurized air and that no source of pressurized air is positively recited. With respect to dimensions not specifically taught, it would have been obvious to optimize tip spacing in order to use known well plates and to optimize tube length and volume to minimize reagent volumes for the dispensing of small volumes (e.g., 1nl to 500 ul [0012]) in order to save on reagent cost, waste, etc. With respect to claims 15-17, it is the examiner's position that the results are inherent.

6. Claims 1, 3-18, 72-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun and Sollbohmer as applied to claims 1, 3-6, 8-18 above, and further in view of Peck et al and/or Krug et al.

Sun and Sollbohmer fails to teach air pressurization.

Peck et al teaches a dispenser similar to that of Sun, including gas pressure to pump fluid from containers through lines to dispensers (Fig. 2).

Krug et al teaches a dispenser similar to that of Sun, including gas pressure to pump fluid from containers through lines to dispensers (Fig. 1).

It would have been obvious to one of ordinary skill to use gas pressurization to pump fluid to a dispensing tip in the apparatus of Sun and Sollbohmer in order to provide an alternative method of fluid pumping in a dispensing device as taught by Peck

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and/or Krug. With respect to the alternative rejection of claims 1, 3-6, 8-18, the alternative pumping arrangement taught by Peck and/or Krug includes the claimed configuration. The examiner notes that in this rejection "Downs" has been changed to "Sun" to correct an obvious editorial error.

7. Claims 1, 3-18, 72-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/67114 (hereafter WO) in view of Sollbohmer (2002/0051737).

8. WO teaches frame 4, dispensing module including reagent containers 6, 7, pressurized air manifold 8, and dispense tips 13, 14 over moveable assay plate on an X-Y stage.

WO fails to teach the dispensers in a module removably attached to the frame.

Sollbohmer teaches a dispensing module including tips 12, pumps 46 and reagent containers 24 on head 10 removably coupled to frame 22 by sliding (quick) connectors 50, 52.

9. It would have been obvious to one of ordinary skill in the art to provide the tips, pumps, valves and reagent containers of WO in a dispensing module like that of Sollbohmer in order to provide an easily replaceable dispensing module in an analytical device as taught by Sollbohmer. With respect to dimensions not specifically taught, it would have been obvious to optimize tip spacing in order to use known well plates and to optimize tube length and volume to minimize reagent volumes for the dispensing of small volumes in order to save on reagent cost, waste, etc. With respect to claims 15-17, it is the examiner's position that the results are inherent.

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10. Applicant's arguments filed August 23, 2006 have been fully considered but they are not persuasive.

11. Applicant argues that Sun and Sollbohmer do not teach air pressurization, but neither does claim 1 require air pressurization as written. In claim 1, each reagent container is "configured to receive pressurized air" but no source of air pressure is claimed. In response to applicant's argument that Sun and Sollbohmer do not teach air pressurization, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the reagent containers of Sun are structurally capable of receiving pressurized air in that they are reasonably expected to be solid containers for holding liquid, such as containers made of glass, plastic or stainless steel, and it is the examiner's position that they are thus reasonably expected to be capable of receiving some unspecified amount of air pressure.

12. Applicant argues that there is no motivation to combine Sun or Sollbohmer with Peck and/or Krug because the primary references already include a pumping mechanism and there is therefore no need for an alternative pumping method using gas pressurization to move fluid to the tip or motivation to add gas pressurization. However, Peck and Krug show alternative methods for moving fluid from a reservoir to a dispensing tip in devices similar to that of Sun, and it is the examiner's position that it would have been obvious to substitute the air pressurized pumping of Peck and/or Krug

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for the syringe pumping of Sun in that Peck and/or Krug teach art recognized equivalents for syringe pumping in the dispensing art. Applicant's argument that adding air pressurization to the pumping system of Sun would not be successful is not persuasive because the pumping mechanism of Krug and/or Peck is an alternative to (i.e., substitute for) that of Sun, not in addition to the pumping mechanism of Sun. Applicant argues that it is not clear if the containers of Sun are capable of pressurization, but in that they are reasonably expected to be solid containers for holding liquid, such as containers made of glass, plastic or stainless steel, it is the examiner's position that they are thus reasonably expected to be capable of receiving some unspecified amount of air pressure.

13. Applicant argues that Sun does not teach a rectangular array of tips, but the instant disclosure teaches that a rectangular array as the term is used in this application is an array having two or more tips and includes linear arrays, e.g., 1x2, 2x1, 1x3 etc. (instant page 12, paragraph [0044]).

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on August 23, 2006 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within




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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jan M. Ludlow  
Primary Examiner  
Art Unit 1743

Jml  
October 31, 2006